

REMARKS/ARGUMENTS

By this paper, Applicant replies to the Office Action of June 4, 2010 and respectfully requests reconsideration of the application.

Claims 1-41 are now pending, a total of 41 claims. Claims 6 and 14 are independent.

Two previous Actions have been withdrawn, one under MPEP § 710.06 for inadequate compliance with procedure, and another *sua sponte* by the Office. This Action is in the same category as the two previous Actions.

I. Non-transitory memory

A memorandum¹ from Director Kappos to the examining corps of January 26, 2010 provides that amendments reciting “non-transitory memory” will not be considered new matter, except in narrow circumstances not present here.

II. Paragraph 9 of the Action

Paragraph 9 of the Action is not understood. Paragraph 9 reads as follows:

9. Claims 6, 7, 14, 15 and 17-41 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The added material which is not supported by the original disclosure is as follows: computer data signals conveying two passive orders to be mediated with assistance of the computer system; a database indicating that a first/second of the two passive orders is entered; and, electronically determining the presentation of the first/second passive order which are critical or essential to the practice of the invention, is not enabled by the disclosure. See *in re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The above elements are considered new matter because they are elements represented in the independent claims 6 and 14 and are not supported in the specification. Dependent claims 7, 17 and 17-41 do not cure this deficiency and are therefore also rejected.

¹ http://www.uspto.gov/patents/law/notices/101_crm_20100127.pdf

This paragraph seems to have been intended to invoke Form Paragraph 7.33.01, which reads as follows:

¶ 7.33.01 Rejection, 35 U.S.C. 112, 1st Paragraph, Essential Subject Matter Missing From Claims (Enablement)

Claim [1] rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. [2] critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). [3]

Examiner Note

....

2. In bracket 2, recite the subject matter omitted from the claims.
3. In bracket 3, give the rationale for considering the omitted subject matter critical or essential.
4. The examiner shall cite the statement, argument, date, drawing, or other evidence which demonstrates that a particular feature was considered essential by the applicant, is not reflected in the claims which are rejected.

The Action is truly remarkable.

- Where note [2] asks the examiner to identify “subject matter omitted from the claims,” the Action identifies subject matter *included* in the claims.
- Where note [3] asks the examiner to “give the rationale for considering the omitted subject matter critical or essential,” the Action discusses facts that are irrelevant to any showing of “critical or essential.”
- Note [4]? The Examiner simply ignores these instructions.

MPEP § 2164.04 gives the following instructions for “enablement” rejections, in pertinent part (citations and quotations omitted):

2164.04 Burden on the Examiner Under the Enablement Requirement

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. ... A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. ... As stated by the court, “it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.”

... the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments.

[T]he analysis and conclusion of a lack of enablement are based on the [Wands] factors discussed in MPEP § 2164.01(a) and the evidence as a whole... The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

The Office Action simply ignores all instructions in the MPEP. The Office Action never even mentions “undue experimentation.” The Office Action never mentions the *Wands* factors. The Office Action makes none of the showings and considers none of the factors that are procedurally required by MPEP § 2164.04 to bring any rejection into existence. No rejection exists. Nor does the Action communicate anything relevant under MPEP § 2164.08(c).

The Office Action plays mix and match with the “new matter” requirement and the “enablement” requirement. The two requirements are separate, and may not be combined as in the Action.

The Action omits all the showings that would make an intelligible rejection. The Action also skips the steps required by the relevant MPEP sections. Without the complete set of showings required by the relevant form paragraph and relevant MPEP section, no rejection exists.

Because the Office Action is a departure from the Office’s rules, it raises no rejection. When an examiner makes up the law out of thin air, and an Action departs from MPEP procedures, applicants have no idea what an examiner is talking about or objecting to. Should the Examiner come forward with some *bona fide* attempt to reject these claims in any future Action, it will be a “new ground of rejection not necessitated by amendment.”

III. Claim 8

¶ 17 of the Action discusses claim 8 in one sentence at page 5, “Silverman ’583 discloses the information in Claims 3-5 8 and 11-13. See the rejections of Claims 1 and 9 above.”

Claim 8 has limitations that are not in either claims 1 or 9.

The Action never addresses the language of claim 8. Claim 8 is not rejected.

IV. Conclusion

Applicant hereby authorizes the USPTO to communicate with any authorized representative concerning this application by electronic mail.

In the event that further extension of time is required, Applicant petitions for that extension of time required to make this reply timely.

In view of these remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. For the entire pendency of this application, the Commissioner is hereby authorized to charge any additional required fees (including all extension of time fees), or credit any overpayment, to Deposit Account No. 50-3938, Order No. 01-1034.

Respectfully submitted,

ATTORNEY FOR ASSIGNEE

Dated: December 6, 2010

By: /David E. Boundy/
Registration No. 36,461

Cantor Fitzgerald L.P.
110 East 59th St.
New York, NY 10022
(212) 294-7848
(917) 677-8511 (FAX)